

Appl. No. : 09/147,861  
Filed : March 17, 1999

**REMARKS**

**Rejection under 35 U.S.C. § 103(a)**

Claims 1-9 are rejected under 35 U.S.C. § 103(a) as being unpatentable over US Patent No. 5,246,780 to Farer, et al.

The Examiner asserts that Farer et al. disclose coated particles for use in cosmetic preparations which are spherical particles having a first coating material applied which is a coupling agent selected from the group consisting of silanes and titanates and a second coating material and that the preferred coating is boron nitrate although other suitable coatings are acceptable including silicone powders, zirconium dioxide and titanium dioxide. Although Farer, et al do not teach the refractive index or the specific percentages claimed by Applicants, the Examiner deems these to be inherent and part of the process of normal optimization, respectively. The Examiner suggested submission of comparative data to show that the materials in the composition of Farer, et al. do not possess the same refractive indices as claimed by Applicant and that the difference in percentage of coating materials creates an unexpected and surprising result.

In response, Applicants submit the Declaration of Masaharu Takatori (Declaration) which compares the presently claimed invention to the cited art and intends to show that the concentration range of 1-30% for the second coating layer as claimed by Applicants is critical to achieving the object of the invention and that the concentration of the second layer affects critical properties of the coated powder which pertain to its use as a cosmetic agent.

The purpose of the present invention is to provide a powder that can accomplish natural coloring without deteriorating lightness. The presently claimed invention specifies an amount of the second coating layer of a coated powder in a certain range. Specifically, claim 1 recites that the amount of the coating layer (C) is 1-30% by weight based upon the total amount of the coated powder. On the other hand, the amount of the second coating layer disclosed in Farer, et al. is 50-99% by weight based on the total amount of the coated powder (col. 3, lines 2-4 of Farer, et al.).

The properties of coated powders prepared according to Farer, et al. were compared to coated powders prepared according to the invention. The attached Declaration describes preparation of the coated powders that correspond to Farer, et al. (Comparative Examples 1-3).

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Responsive to the Examiner's suggestion, coated powders were prepared having a weight percent in the range disclosed by Farer, et al., for comparison with the coated powders of the presently claimed invention. Each of the coated powders of the Comparative Examples 1-3 has a first coating layer which is 2% by weight and a second coating layer which is 50-99% by weight based upon the total amount of the coated powder (see Table 1).

Referring to Table 5 of the Declaration, foundations containing the coated powders according to the present invention and according to the Comparative Examples corresponding to Farer, et al. were evaluated by 5 female panelists. The 5 panelists all rated the foundation containing the coated powder of Comparative Examples 1-3, corresponding to the teaching of Farer, et al. as either having more unnatural whiteness than a non-made-up face or at least a slightly unnatural whiteness compared to a non-made-up face. On the other hand, the foundation containing the coated powder according to the presently claimed invention was rated as giving the impression of a non-made-up face. That is, the foundation containing the coated powder according to the claimed invention presented a more natural finishing, similar to non-made-up skin. The coated powder of the presently claimed invention does not deteriorate the lightness and can approximate a more natural coloring than the coated powder of the comparative examples, corresponding to the cited reference (Farer, et al.).

The reason for the more natural coloring achieved with the coated powder of the claimed invention may be explained as follows. As discussed in the specification at page 2, lines 7-22, when the refractive indexes of the core and two coating layers are in the claimed ranges, then the linear transmittance can be controlled by controlling the thickness of the coating layers and a natural coloring is achieved. Linear light transmission is adjusted by controlling the thickness of each layer. The resulting coated particle according to the claimed invention has a high total transmission of light. As shown in Tables 2 and 4 of the Declaration, the degree of linear light transmission can be adjusted for the coated powder according to the present invention without lowering the total transmission of the light. Furthermore, Tables 2 and 4 indicate that the degree of linear transmission of light is at a lower value than that of the coated powder of the Comparative Examples. This result could not have been predicted from the teaching of Farer, et al.

Since the coated powder according to the present invention has a lower value for degree of linear transmission of light, the light is properly diffused. Thus, the foundation containing the

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coated powder of the present invention has a state of diffusion of light, similar to the state of diffusion of light on non-made-up skin. This property is reflected in the rating of the foundation containing the coated powder by the five panelists. The foundation prepared with the coated powder according to the invention was rated as closer to non-made-up skin by the 5 panelists.

The coated powder of the Comparative Examples has a high linear transmittance. Thus, the amount of light that advances directly is large and the light in the foundation containing the coated powder of the Comparative Examples is less diffuse compared to non-made-up skin. Consequently, the foundation containing the coated powder according to the Comparative Examples lacks a natural quality as reflected in the response of the 5 panelists (Table 5 of Declaration). Furthermore, when the linear transmittance of the light is higher, the whiteness of titanium contained in the foundation is more readily perceived. Thus, the foundation made from the coated powders of the Comparative Examples presents an unnatural whiteness and a less natural look as evaluated by the panelists.

The coated powders of the presently claimed invention are not obvious in view of Farer, et al. because Farer, et al. do not teach or suggest the weight percent in the second layer which is critical to achieve the goal of the invention which is a more natural coloring. The wt% range taught by Farer, et al. is completely outside the range taught and claimed by Applicants. Natural coloring is not achieved by following the teachings of Farer, et al. because Farer, et al. teach a much higher wt% in the second layer.

Additionally, Applicants have provided evidence that the diffraction of light for the claimed invention differs from the coated powders of Farer, et al. As the thickness of the layers is different, the balance between light diffusion and light refraction is also different as reflected in the linear transmittance and the ratings provided by the panelists.

The Declaration shows that the coated powders of Farer, et al. have different physical characteristics than the coated powders of Applicants' claimed invention (different linear light transmission) and this in turn affects their characteristics when used as a cosmetic as shown in Table 5 of the Declaration. Thus, as discussed, the coated powder as taught by Farer, et al. which has a second layer which contains a higher percentage than the present invention, does not achieve the object of the present invention which is natural coloring. Thus, the specific combination of claimed parameters, thickness of coating layer (C) and the refractive indexes as claimed for (A), (B) and (C) (claim 1), are critical to achieve the claimed invention and are not

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taught by the cited reference. Practice of the claimed invention according to the critical parameters produced results that were unexpected, i.e., the coated powders had a lower linear light transmission and produced an effect of more natural coloring when used in a cosmetic foundation. This result was unexpected in view of the art of record.

In view of Applicants' arguments and Declaration, reconsideration and withdrawal of this ground of rejection is respectfully requested.

### **CONCLUSION**

In view of the foregoing Remarks, it is respectfully submitted that the present application is in condition for allowance. Should the Examiner have any remaining concerns which might prevent the prompt allowance of the application, the Examiner is respectfully invited to contact the undersigned at the telephone number appearing below.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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